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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,372	12/01/2000	Hans-Rudolf Nageli	ATM-2273	5299
7590	04/01/2004			
Virgil H. Marsh Fisher, Christen & Sabol Suite 1401 1725 K Street, N.W. Washington, DC 20006			EXAMINER TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 04/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,372

Applicant(s)

NAGELI ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Amendment

1. Amendment filed on February 19, 2004 has been entered. New claim 55 has been added. Claims 28-55 are pending in the application.

Specification

2. The amendment filed on November 26, 2002 stands objected to under 35 U.S.C. 132 as introducing new matter into the disclosure for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on February 13, 2003 (Paper No. 9).

Claim Objections

3. Objection to claim 55 because of informalities has been withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 28-55 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A recitation "the temperature at the surface of the plastic coating (14) and the adhesion-promotion agent (16) lies *below* the crystallite melt point (Tk) of the plastic" in independent claim 28 is a new matter since it was not described in the specification as filed.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 28, 29, 51, 52** are rejected under 35 U.S.C. 102(b) as anticipated by Heyes et al (US 5,093,208) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on February 13, 2003 (Paper No. 9).

8. **Claim 55** stands rejected under 35 U.S.C. 102(b) as anticipated by Heyes et al (US 5,093,208) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on August 5, 2003.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 30-50, 53, 54** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heyes et al (US 5,093,208) in view of Takano et al (US 5,837,360) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on February 13, 2003 (Paper No. 9).

Response to Arguments

11. Applicant's arguments filed February 19, 2004 have been fully considered but they are not persuasive.

(A) Applicants argue that the Examiner has not carried burden of proof of factual establishment of a new matter.

The Examiner respectfully disagrees with this argument. The Examiner expressly stated in the Office Action mailed on February 13, 2003 (Paper No. 9) that the material added with the Amendment filed on November 26, 2002, which is not supported by the original disclosure is as follows: *"The temperature of the aluminum foil, with which the coextruded plastic and adhesion-promotion agent is being combined, is such that the temperature at the surface of the plastic coating and the adhesion-promotion agent lies **below** the crystallite melt point (T_k) of the plastic" because it introduces new matter into the disclosure.* To overcome the Examiner's statement of introducing a new matter, Applicants have *burden of proof* that the Amendment is not a new matter **not** by scientific/technical principles and the knowledge of one skilled in the art, **but** pointing **pages and lines** of the specification as filed showing **factual language** describing the Amendment.

(B) Applicants argue that Heyes et al are limited to "thermoplastic polyesters" since Heyes et al show in comparative examples that polyolefin provide unsatisfactory results.

It is held that PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. Disclosed examples and preferred embodiments do **not** constitute a **teaching away** from a broader

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disclosure or **nonpreferred embodiments**. See MPEP 2123. Therefore, Pettus does teach that the process can be used for coating a chrome plated substrate, may be with inferior results than for aluminum substrates. But again, it is expected since according to Applicants "It is well known in the art that chrome surfaces are more difficult to coat than aluminum".

Conclusion

12 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'E. Tsoy'.

Elena Tsoy
Examiner
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March 24, 2004